

Appl. No.: 09/981,920
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REMARKS

Claims 1-9 are pending in this application. Claims 1, 4 and 7 are independent claims. By this amendment, the specification and claims 1-6 are amended in large part for clarity to correct minor informalities contained therein.

Reconsideration in view of the above amendments and following remarks is respectfully solicited.

The Claims Satisfy The Requirements Of
35 U.S.C. §112, 2nd Paragraph

The Office Action reject claims 1 and 4 under 35 U.S.C. §112, 2nd paragraph. This rejection is respectfully traversed.

Applicant respectfully submits that the amendment to claims 1 and 4 obviates the rejection of claims 1 and 4 under 35 U.S.C. §112, 2nd paragraph.

The Claim Objections Are Obviated

The Office Action objects to claims 1, 2 and 4 for minor informalities contained therein. This objection is respectfully traversed.

Applicant respectfully submits that the amendment to claims 1, 2 and 4 obviates the objection of the claims.

Accordingly, withdrawal of the objection to claims 1, 2 and 4 is respectfully solicited.

The Claims Define Patentable Subject Matter

The Office Action makes the following rejections:

(1) claims 1, 2, 4 and 5 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,499,294 to Friedman (hereafter Friedman);

(2) claim 7 is rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,875,249 to Mintzer et al. (hereafter Mintzer);

(3) claims 1-3 and 7-9 are rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Publication No. US 2003/0065922 A1 to Fredlund et al. (hereafter Fredlund);

(4) claims 3 and 6 are rejected under 35 U.S.C. §103(a) as being unpatentable over Friedman;

(5) claims 8 and 9 are rejected under 35 U.S.C. §103(a) as being unpatentable over Mintzer; and

(6) claims 4-6 are rejected under 35 U.S.C. §103(a) as being unpatentable over Fredlund in view of U.S. Patent Publication No. US 2002/0114452 A1 to Hamilton (hereafter Hamilton).

These rejections are respectfully traversed.

Applicant respectfully submits that the cited references, either alone or in the cited combinations, fail to teach or suggest each and every feature as set forth in the claimed invention.

Friedman Reference

Applicant respectfully submits that the claimed invention as set forth in claims 1-6 is distinguishable from Friedman. For example, the Examiner alleges that Friedman's "image file hash" reads upon the claimed image characteristic amount and Friedman's "public key" reads upon the claimed identification information.

However, Friedman merely discloses that a digital camera is equipped with the means for providing a hash of the image file and means for encrypting the hash with a unique private key embedded in the digital camera system. A public key unique to the digital camera system is used to decrypt the file. The encrypted hash is stored as a digital signature along with the image file and public key for later authentication. (see Friedman, col. 4, lines 29-46).

However, in contrast with the Friedman, the claimed image characteristic amount is distinguishable from Friedman's "image file hash" because Friedman uses a "predetermined algorithm" for calculating its hash. (see Friedman, Abstract). On the other hand, in the claimed invention, the algorithm used is desirably confidential.

As such, for example, in the present invention a plurality of algorithm may be prepared wherein one is randomly selected using the camera in each photographing session. Alternatively, in the present application, the algorithm may be selected according to an instruction signal from the authentication section. (see present specification, page 16). Friedman is not concerned at all with keeping its hashing algorithm secret. (see Friedman, col. 6, lines 31-37). Friedman merely uses a predetermined algorithm.

As such, the present invention is at least distinguishable from Friedman in that the present invention uses a confidential algorithm that may be randomly selected.

In addition, applicant respectfully submits that the claimed "identification information" is distinguishable from Friedman's "public key". The Examiner alleges that Friedman's public key is unique to the camera, therefore it identifies the camera. (see office Action, page 5, 1st paragraph). We disagree with assertion.

Applicant respectfully points out that the public key is really unique to the private key, which is embedded in the camera, not the camera itself. Further, Friedman fails to identify any type of file name for the image or a photographer of the image.

Furthermore, Friedman merely compares the image hash from the hash calculator with the secure image hash from the decryptor and if these two hash match, the images are said to be identical. However, in Friedman, if even one single bit in the image being authenticated has been altered, the two hashes will not match and the image authenticity will not be affirmed. (see Friedman, col. 6, lines 31-52).

However, in the present invention, the exact matching between the data is not required and a consistency which is equal to a predetermined value or larger is regarded to be sufficient. (see present specification, page 20).

As such, we believe the present invention is further distinguishable from Friedman in that exact matches are not required in the present case for authentication to be confirmed.

Accordingly, withdrawal of the rejection of the claims under Friedman is respectfully requested.

Mintzer Reference

Applicant also respectfully submits that the present invention is distinguishable from Mintzer for at least the following reasons:

For example, the Examiner alleges that Mintzer discloses identification information for identifying the produced image and the storage of the same. Upon a close review of Mintzer, we fail to see where this identification information feature is taught. Mintzer merely discloses stamping information 100 being combined with the source image 101 to produce a stamped source image 104. In Mintzer, this stamping process is carried out in a digital computer.

The Examiner further goes on to take Official Notice that digital cameras, as well as providing authentication to the camera, is well known in producing images. (see Office Action, page 11-12). We disagree with this assertion. We do not believe it is well known to use a digital camera with identification information as set forth in the present invention.

Furthermore, applicant respectfully submits that Mintzer fails to associate its process with a digital camera. Instead, Mintzer uses a computer system 110 connected to a network with a imager server 108 in order to realize its invention. The server 108 in Mintzer verifies the integrity of the image data stored in the archive 106. As such, Mintzer fails to teach or suggest a digital

camera as used in the present invention and identification information relating to an image.

Furthermore, Mintzer fails to disclose recording identification information for identifying the produced image wherein such identifying information identifies a camera or a file name of the photographic image or an photographer of the photographic image.

Accordingly, withdrawal of the rejection of the claims under Mintzer is respectfully requested.

According to MPEP §2131, "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. Of California*, 814 F.2d 628, 631, 2 USPQ2d 1051 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ...claims." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913 (Fed. Cir. 1989). The elements must be arranged as required by the claims, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Applicant respectfully submits that the Office Action has failed to establish the required *prima facie* case of anticipation because the cited references, Mintzer and Friedman, both fail to teach or suggest each and every feature as set forth in the claimed invention.

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Applicant respectfully submits that independent claims 1, 4 and 7 are allowable over both Friedman and Mintzer for at least the reasons noted above.

As for each of the dependent claims not particularly discussed above, these claims are also allowable for at least the reasons set forth above regarding their corresponding independent claims, and/or for the further features claimed therein.

Accordingly, withdrawal of the rejection of claims 1, 2, 4, 5, 7 under 35 U.S.C. §102(b) is respectfully solicited.

Fredlund Reference is Disqualified

As for the Fredlund reference, applicant respectfully submits that Fredlund is disqualified as prior art.

In other words, applicant respectfully submits that because the priority document of the present application predates the Fredlund reference, and an English translation of our priority document is filed herewith (i.e., perfecting our priority claim), the Fredlund reference must now be removed as prior art.

Accordingly, withdrawal of the rejection of claims 1-3 and 7-9 under Fredlund is respectfully requested.

Rejections under 35 U.S.C. §103(a)

Friedman and Mintzer

For at least the reasons noted above, applicant respectfully submits that claims 3, 6, 8 and 9 are distinguishable from Friedman and/or Mintzer. The Examiner merely takes Office Notice that using

computers as an imaging apparatus or using digital cameras is well known in the art. However, the Examiner has failed to show how using computers and/or digital cameras in combination with the many other features of the present invention is well known.

As such, unless the Examiner can provide support, in the form of a reference, to prove his allegations, applicant respectfully requests that the Examiner withdrawn such improper Official Notice rejections of claims 3, 6, 8 and 9 under section 103(a).

Fredlund in view of Hamilton Disqualified as prior art

As noted above, Fredlund is disqualified as prior art. In addition, Hamilton similarly should be disqualified.

Specifically, like Fredlund, the Hamilton reference is also disqualified as prior art due to our perfecting the filing of our priority document.

In other words, because applicant's priority document predates the Hamilton reference, and an English translation of our priority document is filed herewith, both the Hamilton and Fredlund references must now be removed as prior art.

Accordingly, withdrawal of the rejection of the claims under the combination of Fredlund and Hamilton is respectfully requested.

To establish a *prima facie* case of Obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there

must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP 706.02(j).

Applicant respectfully submits that the cited art fails to provide a *prima facie* case for obviousness of the present invention for at least the reasons noted above.

Accordingly, withdrawal of the rejection of claims 3- 6, 8, and 9 under 35 U.S.C. §103(a) is respectfully requested.

Conclusion

In view of the foregoing, Applicant respectfully submits that the application is in condition for allowance. Favorable reconsideration and prompt allowance are earnestly solicited.

Applicant respectfully petitions under the provisions of 37 C.F.R. §1.136(a) and §1.17 for three (3) months extension of time in which to respond to the Examiner's Office Action. The appropriate Extension of Time Fee is attached hereto.

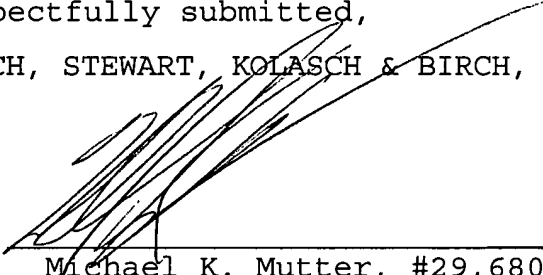
Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact Carolyn T. Baumgardner (Reg. No. 41,345) at (703) 205-8000 to schedule a Personal Interview.

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If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment from or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §1.16 or under 37 C.F.R. §1.17; particularly, the extension of time fees.

Respectfully submitted,
BIRCH, STEWART, KOLASCH & BIRCH, LLP

By


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Attachment(s): English Translation of Priority Document 2000-320229